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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,479	LARK, DAVID	
Examiner	Art Unit		
C. Marks	3713		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 September 2001 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3. 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the playing cards" in line 2, "the card fronts" in line 2, "the card backs" in line 3. There is insufficient antecedent basis for this limitation in the claim. Independent claim 7, from which claim 10 depends, recites no limitation of playing cards and makes reference only to keno numbers and keno number spaces.

For examination purposes, claim 10 will be examined as best understood with regard to its literal meaning by the Examiner

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 10-14 and 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US Patent No. 6,146,273).

Olsen discloses a gaming system and a gaming method that includes a number of gaming apparatus that are enclosed within a cabinet having a front face and a gaming display supported inside the cabinet operable to generate images (FIG 7, reference G). The gaming machine inherently has a controller coupled to the display that comprises a memory coupled to a processor; as such configurations are inherent to the functionality of the gaming machine.

Players can play one or more games on the gaming machine (Column 1, lines 20-24) by inserting a wager (Column 1, lines 19-21). Upon the insertion of money, the controller is then programmed to cause an image associated with the game to be played (Column 1, lines 35-57). If the player wins the game, the player is given a payout associated with the outcome of the game (Column 1, lines 43-45). Further, all these functions of a gaming machine are notoriously well known in the art.

Olsen also discloses that the controller is programmed to display on the gaming display a plurality of segments (Column 21, lines 17-18) in the form of squares wherein the squares change from the display of the square to display a portion of a display object that is behind the segment wherein the portions of the display object create an identifiable image (Column 21, lines 20-25).

Olsen discloses the segments to be in the shape of a square or rectangle (Column 21, lines 17-18). Olsen does not disclose that the segments are playing cards, keno number spaces, or bingo number spaces; however, such an incorporation would have been obvious to one of ordinary skill in the art as all three are well known types of rectangles used in the gaming industry and thus would be suggested to one of ordinary skill in the art through the disclosure of Olsen. Further, absent a showing of criticality, the type of indicia used to cover up the image disposed beneath the indicia, would have been obvious to one of ordinary skill in the art as all would serve the same purpose of hiding the image below until the controller is programmed to allow for the image to be displayed.

In regards to claims 2, 8, and 14, Olsen does not explicitly disclose the process to which the image is covered back up. However, it would have been obvious to one of ordinary skill in the art that for the bonus game of Olsen to function as disclosed, there would inherently come a point in the game where the player would either win or lose and at this point, the image would need to be further covered up for future bonus games to be able to be played. Thus, progressively changing the displayed portion of the displayed object back to the card segments initially covering up said object would have been obvious to one of ordinary skill in the art as suggested by the functionality of Olsen in using the segments to hide part of the image when the image is to be used in the bonus game as disclosed.

In regards to claims 3 and 10, Olsen discloses that the controller is programmed to cause the segments to change from displaying the segments to displaying a portion of the display object when the apparatus is in the bonus mode (Column 21, lines 17-25). Olsen does not disclose that this event occurs when the gaming apparatus is in the attract mode. However,

Olsen does disclose that a feature of the object displayed is that it can be used along with sound and visual indicators to attract persons in the vicinity of the picture being displayed to witness the bonus jackpots accumulated (Column 11, lines 32-41). A signal is also used to start the process of displaying the image from behind the segments (Column 21, lines 14-16). Therefore, it would have been obvious to one of ordinary skill in the art to use the disclosure of Olsen regarding attracting a player to witness a bonus game in a second and alternative manner as a separate attract mode to allow players to be attracted to the machine not only during the bonus game, but also at idle times. Using the attract mode would thus garnish the attention of players passing by and possibly draw them to play the machine wherein profit would thus be increased. Such attract modes are notoriously well known in the art and thus would have been obvious to one of ordinary skill in such art.

In regards to claims 4, 11, and 16, Olsen discloses that it is well known in the art that gaming machines are well known to include a variety of games such as slot, poker, and keno (Column 1, lines 17-18).

In regards to claims 5, 6, 12 and 17, Olsen also discloses that it is well known to link individual gaming machines together in order to create a networked of such apparatus (Column 1, lines 62-63; FIG 2). Further, it is notoriously well known that this network could be any type of known communication medium used in the gaming industry to allow gaming machines networked together to communicate thus including the Internet.

In regards to claim 18-20, what Olsen discloses, teaches, and/or suggests has been discussed above and is incorporated herein. Olsen states that gaming machines can be programmed to play a variety of games and lists poker as such a game (Column 1, lines 16-20).

Olsen also discloses that the gaming machine plays the game according to the rules of the game (Column 1, lines 43-44). Thus, when playing the game of poker, the video game would inherently allow for the display to comprise an image of playing cards that would have both fronts and backs. As disclosed above, Olsen allows a gaming mode to have a square segment cover up an identifiable display object and it would have been obvious to one of ordinary skill in the art to have these square segments be playing cards or the like in order to visually and quickly inform the user of the type of gaming machine (i.e. cards, bingo, keno, slots, etc.).

In regards to claim 21-24, what Olsen discloses has been discussed above and is incorporated herein. As disclosed above, Olsen allows for a number of base games to be played on the gaming machine including a poker game and that the gaming machine will play the game according to the rules of the game. Therefore, it would have been obvious to one of ordinary skill in the art that five cards would be displayed upon playing video poker, as it is well known in the art that the majority of poker games are based upon a five-card hand.

Further, it is notoriously well known in the art that gaming machines have a memory wherein the program to be executed will be stored in order for the device to function. This memory will also store instruction relating to the acceptance of wagers, the control of the display, and the selection of games. Further, the computer program would determine if the outcome of the game displayed is indeed a winning or losing outcome and associate a payout with the outcome. It is also notoriously well known that the memory storing the program would also be used to control any extra features or bonuses incorporated into the game, such as the turning of the segments and the image disposed below as disclosed by Olsen.

Storing the program in memory would be inherent to the functionality of Olsen as discussed above and Olsen states that in the machine memory, all the necessary data for the graphical displays is stored (Column 25, lines 22-25). Though Olsen does not explicitly disclose that a program is used in controlling all these functions and that the program is stored in memory, it would be obvious to one of ordinary skill in the art as such facts are notoriously well known in the construction of gaming machines. Likewise, it is notoriously well known and disclosed as being well known by Olsen (Column 6, lines 1-10) that a memory has a number of registers for storing different data. Thus it would be obvious to one of ordinary skill in the art to partition the data in the memory into these specific register partitions in order to be responsible for certain specific functions.

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US Patent No 6,146,273) in view of Frohm et al. (US Patent No. 6,159,095).

What Olsen discloses, teaches, and/or suggests has been discussed above and is incorporated herein.

Frohm et al. discloses a game wherein a plurality of squares are displayed and upon the calling of a specific number, the display is changed from displaying the keno square to the highlighted version indicating a specific keno number (Column 8, lines 43-50). The images of the squares are changed to represent that a number has been called. Though Frohm et al. disclose a keno embodiment, it is notoriously well known in the art that bingo and keno are art related games and thus would be obvious over each other.

Olsen discloses the squares are uncovered based upon a signal from the computer. However, Olsen does not explicitly disclose the process to which the image is covered back up. However, it would have been obvious to one of ordinary skill in the art that for the bonus game of Olsen to function as disclosed, there would inherently come a point in the game where the player would either win or lose and at this point, the image would need to be further covered up for future bonus games to be able to be played. Thus, progressively changing the displayed portion of the displayed object back to the segments initially covering up said object would have been obvious to one of ordinary skill in the art as suggested by the functionality of Olsen in using the segments to hide part of the image when the image is to be used in the bonus game as disclosed. Further, it would have been obvious based upon the fact that it is notoriously well known in the art that the bonus game usually directly relates to the base game, to incorporate this covering up into a direct relationship of the base game wherein the squares will serve more than one purpose. By allowing the squares to serve a double purpose as a part of the base game, the player will feel a better understanding of how the two are related and therefore be more likely to participate.

It would have been obvious to one of ordinary skill in the art to incorporate the bonus game back into the base game by covering up the image in the bonus game during the base game thus allowing the bonus game to be directly related to the base game as is well known in the art. Further, it would have been obvious, as disclosed by Frohm et al., to perform this covering by changing a displayed object to the specific bingo number as selected by the game in order to perform this cover up. By incorporating the base game directly into the bonus game disclosed by Olsen in the manner as disclosed by Frohm et al., the bonus game would always be a part of the

game and therefore would serve as a constant reminder to the player as to the possibility of such a game, thus continually urging the player to play.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,533,273:** Gaming machine that displays a plurality of indicia the comprises a video display with the indicia in a grid format and the grid defines locations whereupon each space on the board can be filled in with a cover and the cover can be removed to reveal the indicia.

**US Patent No. 6,398,644:** Gaming machine that comprises a virtual matrix comprised of a plurality of grid elements on which a hidden pattern is concealed beneath.

**US Patent No. 6,514,141:** Gaming machine that has a bonus display that includes masking part of the underneath image as to conceal it from the player.

**US Patent No. 6,089,976:** Gaming device that provides a plurality of icons that mask an image underneath to conceal it from the player and allow the player to choose an icon which will then be overturned to present the player with the image.

**US Patent No. 6,261,177:** Gaming device that has an image displayed and hidden beneath a number of tiles wherein the user can select a tile to display the image underneath.

**US Patent No. 6,309,300:** Gaming device that has images disposed under icons in which a player can choose an icon to display the image disposed underneath.

**US Patent No. 5,605,504:** Gaming machine wherein a plurality of tiles are in the form of playing cards that are initially displayed in a tile format and then are used for play in a game.

**US Patent No. 5,957,774:** Gaming machine with a processor and program to play video poker wherein a plurality of cards are displayed and then the player is allowed to play and includes a deal of five cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

Cmm  
cmm  
May 22, 2003

*MICHAEL O'NEILL*  
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